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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICOLAS BROGNE, JEAN-PIERRE KELLES,
EMMANUEL SUTTER, and ANDREAS C. LEMKE

Appeal 2008-1917
Application 09/667,779
Technology Center 2400

Decided: January 15, 2009

Before HOWARD B. BLANKENSHIP, JEAN R. HOMERE, and ST. JOHN
COURTENAY III, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-12, which are all the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse, and enter a new ground of rejection as permitted by 37 C.F.R. § 41.50(b).

Claim 1 is illustrative.

1. A method of manipulating a sent e-mail addressed by a sender to a plurality of addressees, said sent e-mail comprising an address header and a body, wherein said method comprises:

routing a modification message over a data network to a server that operates independently from any e-mail processing means associated with each of said addressees and on which at least the body of said sent e-mail is stored, said modification message being sent by said sender and for modifying said e-mail body; and

modifying said e-mail body at said server according to said modification message if said e-mail body has not been accessed on said server by any of said addressees, wherein the modification of said e-mail body is denied to all addressees if at least one addressee has accessed said e-mail body on said server, and wherein the modification of said e-mail body occurs at said server independently of any e-mail processing means associated with each of said addressees.

The Examiner relies on the following references as evidence of unpatentability.

Nielsen	US 5,870,548	Feb. 9, 1999
Uchida	US 6,327,610 B2	Dec. 4, 2001 (filed Jun. 24, 1998)

Claims 1, 2, 11, and 12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Nielsen.

Claims 3-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nielsen and Uchida.

I. The Standing Rejections

Instant claim 1 recites routing a modification message over a data network to a server, the message being sent by a sender of an e-mail body that is stored on the server, and modifying the e-mail body at the server according to the modification message if the e-mail body has not been accessed on the server by any of the addressees, “wherein the modification of said e-mail body is denied *to all addressees* if at least one addressee has accessed said e-mail body on said server . . .” (emphasis added).

In Appellants’ invention as disclosed in the initial filing, action by the sender, not an addressee, effects modification of the e-mail body, provided that an addressee has not read the e-mail. (*See* Spec. 9:11-26; Fig. 3, steps 321-324.) The language “to all addressees” was added to claim 1 (and other claims) during prosecution, and may be considered misleading, as the language implies there is a scenario in which an addressee may effect modification of the e-mail body on the server. Appellants concede that the language is inaccurate, in an amendment after final (filed May 23, 2006), which proposed to delete “to all addressees” from the claims. We also observe that although Appellants’ “Summary of Claimed Subject Matter” in the Appeal Brief correctly notes it is the sender that can modify the e-mail body of an earlier sent message, Appellants at the time of filing the Reply Brief seem to have been misled by their own claim language -- “There is no suggestion in Nielsen of the concept of preventing the addressees from modifying an email in response to a modification message sent by the sender.” (Reply Br. 5.)

The Examiner did not enter the proposed amendment after final. However, the Examiner has not entered a § 112 rejection against the claims. In our review of the instant rejections over prior art, we will interpret the “to all addressees” recitation in the claim 1 phrase of “wherein the modification of said e-mail body is denied to all addressees if at least one addressee has accessed said e-mail body on said server” such that the *result* of the modification is denied to all addressees, rather than the *capability* of modifying the e-mail body being denied to the addressees. We enter a new ground of rejection against the claims, *infra*.

In any event, Nielsen describes allowing a sender to modify or cancel a previously sent e-mail message (Figs. 6A-6D) provided that the addressee has not seen the message (Fig. 10A, elements 1011 and 1017, delete the message; Fig. 11A, elements 1117 and 1108, replace the message with the modified version). *See* Nielsen, col. 7, l. 40 - col. 9, l. 22; col. 11, l. 11 - col. 15, l. 39.

However, we agree with Appellants that the Examiner has not shown that Nielsen describes, at least, providing a modification message to a server, and modifying the e-mail body at the server according to the modification message, where modification of the e-mail body is denied (to a sender, to an addressee, or to anybody) if at least one addressee has accessed the e-mail body on the server.

The Examiner’s rejection of claim 1 reads this claimed “server” on Nielsen’s sending e-mail system 200 in “Prior Art” Figure 2. Nielsen’s Figure 2 illustrates the problem in the prior art (with respect to Nielsen) that once an e-mail message leaves e-mail system 200 and enters Internet 205, the message cannot be deleted or modified. *See* Nielsen col. 6, ll. 17-43.

Nielsen's description of the prior art in Figure 2 is not what is presently claimed by Appellants.

In Nielsen's system, software and databases at the message recipient's e-mail system determine whether a previously sent message may be modified or deleted. *See* Nielsen col. 11, ll. 16-43; Fig. 4, elements 409 and 411. In neither the sender's nor the receiver's system as described, however, do we find denying modification of an e-mail body on a server if at least one addressee has accessed the e-mail body on that server.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). We thus cannot sustain the § 102 rejection of claim 1 over Nielsen.

Each remaining claim on appeal recites or incorporates by reference limitations similar to those of claim 1 that we have discussed. Uchida as applied in combination with Nielsen in the § 103(a) rejection of claims 3 through 10 does not remedy the basic deficiencies in the rejection. We therefore cannot sustain the rejection of any claim on appeal.

II. New Ground of Rejection

As permitted by 37 C.F.R. § 41.50(b), we reject claims 1-12 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.

As Appellants acknowledge, the recitation of "to all addressees," as appearing in representative claim 1 and discussed *supra*, reflects an

inaccurate description of Appellants' invention. (*See* Appellants' proposed amendment and Remarks filed May 23, 2006.)¹

CONCLUSION

The rejection of claims 1, 2, 11, and 12 under 35 U.S.C. § 102(e) as being anticipated by Nielsen and the rejection of claims 3-10 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen and Uchida are reversed.

In a new ground of rejection, we reject claims 1-12 under 35 U.S.C. § 112, second paragraph.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

¹ We need not consider whether the claimed subject matter lacks adequate written description (§ 112, first paragraph) support. Based on Appellants' intent to cancel "to all addressees" from the claims, whether the rejection lies under the first or the second paragraph of § 112 does not matter.

Appeal 2008-1917
Application 09/667,779

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED -- 37 C.F.R. § 41.50(b)

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